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Don M. Tamura

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# Copyright Infringement: An Argument for the Elimination of the *Scènes à Faire* Doctrine

By DON M. TAMURA\*

I have heard many people say, "Give me the ideas, it does not matter what words you put them into." These people knew enough of artifice, but nothing of art. Ideas cannot be given but in their minutely appropriate words.

—William Blake<sup>1</sup>

## I Introduction

The poet William Blake accurately summarized the central conundrum of copyright law: distinguishing an idea from an expression of that idea. Although copyright protection for original writings has been a facet of American law since the founding of the nation,<sup>2</sup> courts and lawyers are still attempting to determine the boundaries of copyright protection, with little success.<sup>3</sup> The advent of new forms of expression, primarily in film and radio, has expanded the original scope of Anglo-American copyright law and exacerbated the disparity in reasoning of jurists and scholars.<sup>4</sup> Many theories and models have been proposed to cope with the resultant vagaries of copyright law,

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\* Member, Third Year Class; B.S., University of California, Los Angeles, 1980. A version of this note has been entered in the Nathan Burken Memorial competition.

1. H. BATTEN, M. GOODRICH & G. TOOGOOD, *THE WRITTEN WORD* 64 (1932).

2. U.S. CONST. art. I, § 8.

3. M. NIMMER, 3 *NIMMER ON COPYRIGHT* § 13.03[A] (1981); N. BOORSTYN, *COPYRIGHT LAW* § 10:14 (1981). For an exhaustive review of the history of early copyright law in England and America, see L. PATTERSON, *COPYRIGHT IN HISTORICAL PERSPECTIVE* (1968), and for a concise summary, see Note, *Derivative Works and the Protection of Ideas*, 14 GA. L. REV. 794 (1980).

4. H.R. REP. NO. 1476, 94th Cong., 2d Sess. 51, reprinted in 1976 U.S. CODE CONG. & AD. NEWS 5659, 5664. See also Berman & Boxer, *Copyright Infringement of Audiovisual Works and Characters*, 52 S. CAL. L. REV. 315 (1979). For an example of disparate reasoning in the courts, compare *Miller v. Universal City Studios, Inc.*, 650 F.2d 1365 (5th Cir. 1981) with *Miller v. Universal City Studios, Inc.*, 460 F. Supp. 984 (S.D. Fla. 1978).

but no one proposal has dominated the lively exchanges concerning copyright protection.

In an effort to bring clarity to the evanescent area of copyright infringement, a judge of the federal court for the southern district of California proposed a theory of copyright protection—the *scènes à faire* doctrine.<sup>5</sup> The fanciful nature of the doctrine's name belies the relative simplicity of the doctrine itself.<sup>6</sup> The *scènes à faire* doctrine was designed to protect scenes, events or "stock" situations which are indispensable in the treatment of a particular topic<sup>7</sup> and essentially restates a basic tenet of copyright law: expressions, not ideas, are protected by copyright.<sup>8</sup>

Over the last decade, the *scènes à faire* doctrine has been altered by courts from a mere proposal to a full-blown defense for alleged copyright infringers.<sup>9</sup> Its recent popularity,<sup>10</sup> however, has far outstripped its utility. Although the *scènes à faire* doctrine represents a laudable attempt at defining the breadth of copyright protection, it is inherently vague and cannot be reconciled with accepted models of copyright protection.<sup>11</sup> Notwithstanding this fact, several courts have relied on the doctrine to bolster judicial findings, and in so relying courts have sometimes contravened the original purpose of copyright protection for artistic expressions. No court has relied solely on the *scènes à faire* doctrine to support its reasoning<sup>12</sup> but more courts are using the *scènes à faire* doctrine as the basis for protecting infringing works. A combination of judicial legerdemain and inadequate definitions has transformed the doctrine into a shield for potential infringers.

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5. *Schwarz v. Universal Pictures Co.*, 85 F. Supp. 270 (S.D. Cal. 1945). See *infra* notes 83-92 and accompanying text.

6. Yankwich, *Originality in the Law of Intellectual Property*, 11 F.R.D. 457 (1951).

7. *Id.* at 462-463.

8. 17 U.S.C. app. § 102 (1976); *Chatterton v. Cave*, 3 App. Cas. 438, 501 (1878).

9. *Warner Bros., Inc. v. ABC, Inc.*, 654 F.2d 204 (2d Cir. 1981); *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972 (2d Cir. 1980); *Reyher v. Children's Television Workshop*, 533 F.2d 87 (2d Cir.), *cert. denied*, 429 U.S. 980, 97 S. Ct. 492 (1976); *Jason v. Fonda*, 1981 COPYRIGHT L. REP. (CCH) ¶ 25,321 (Sept. 18, 1981); *Midwood v. Paramount Picture Corp.*, 1981 COPYRIGHT L. REP. (CCH) ¶ 25,292 (Aug. 19, 1981); *Twentieth Century-Fox Film Corp. v. MCA, Inc.*, 209 U.S.P.Q. (BNA) 200 (C.D. Cal. 1980), *aff'd mem.*, No. 78-2437 (9th Cir. May 8, 1981); *Gibson v. CBS, Inc.*, 211 U.S.P.Q. (BNA) 262 (S.D.N.Y. 1980); *Alexander v. Haley*, 460 F. Supp. 40, 200 U.S.P.Q. (BNA) 239 (S.D.N.Y. 1978).

10. With the exception of *Schwarz v. Universal Pictures Co.*, all cases mentioning the *scènes à faire* doctrine have issued opinions in the last five years, see *supra* note 9.

11. See *infra* section IV.

12. See *supra* cases at note 9.

This note will show that the *scènes à faire* doctrine is unnecessary because it lacks uniformity, continuity and is incompatible with other models of copyright protection. The first section will outline the legal requirements for an action in copyright infringement and introduce two major theories of copyright protection—the abstractions test and the patterns test. In addition, this section contains a discussion of a seminal Ninth Circuit decision<sup>13</sup> on procedure in copyright infringement actions. The next section describes the origins of the *scènes à faire* doctrine and its current application. Finally, the note compares the doctrine to more established theories of copyright protection to illuminate the doctrine's flaws and the conflicts between it and other models.

## II

### Background to Copyright Infringement

Copyright law is designed to encourage the creation and distribution of an author's original work.<sup>14</sup> To achieve this goal, the owner of a copyright has the privilege of reproducing and performing the copyrighted work and may grant that privilege to others.<sup>15</sup> A major policy undergirding copyright law is based on a belief that if protection were absent, then unauthorized reproduction would impair the economic interest of the author and curtail creation of new works.<sup>16</sup> A copyright gives the owner control over the "right to copy" his or her work.<sup>17</sup>

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13. *Sid & Marty Krofft Television Prod., Inc. v. McDonald's Corp.*, 562 F.2d 1157 (9th Cir. 1977) [hereinafter cited as *Krofft v. McDonald's*].

14. *Preface* to D. JOHNSTON, *COPYRIGHT HANDBOOK* at xii (1978).

15. 1 M. NIMMER, *supra* note 3, at § 5.01[A]; N. BOORSTYN, *supra* note 3, at § 1:1.

16. N. BOORSTYN, *supra* note 3, at § 1:2; D. JOHNSTON, *supra* note 14, at xii.

17. The history of copyright law began with the "right to copy." There would be no copyright law if not for the printing press. Originally, copyright law focused on who had the right to copy, not what was being copied. The right usually belonged to the publisher. Early English cases dealt with literal reprinting and not the copying of ideas. The earliest English case, *Millar v. Taylor*, 98 Eng. Rep. 201 (K.B. 1769), involved the rights of a publisher to print a book by James Thomson, *The Seasons*.

The focus of copyright law changed, however, when the rights to copy became vested in the author of the work. The first American copyright case dealt with by the Supreme Court was *Wheaton v. Peters*, 33 U.S. 591 (1834). In *Wheaton* the issue was the copying of official reports of the Supreme Court. The court intimated that copying could still be performed by a condensation of the casenotes, but this consideration was only dictum.

It wasn't until several federal cases were decided that the concept of non-identical copying became nascent. Judge Story, the author of many early copyright opinions, wrote:

Copyright protection safeguards imaginative compositions without allowing the owner of the copyright hegemony over ideas embodied in the protected work.<sup>18</sup> According to modern copyright law, ideas are in the public domain. That is, no one can own a copyright of an idea.<sup>19</sup> The rationale behind this policy is that by allowing a person to control the dissemination of ideas, creation of new and original writings and artistic products would be stifled.<sup>20</sup> Therefore, copyright law protects only expressions of ideas because it is thought that, while there are few ideas, there are many expressions of the same idea.<sup>21</sup>

### A. Elements of an Action for Copyright Infringement

In any action for copyright infringement, the plaintiff, the person claiming his or her work has been infringed, must prove two elements: ownership by the plaintiff and copying by the defendant.<sup>22</sup> There are always two works central to every infringement case—a prior work, claimed by the plaintiff, and a second work, claimed by the defendant. The plaintiff must show by a preponderance of evidence that the second work infringed the prior work.<sup>23</sup>

Ownership may be proven by evidence of original creation of the prior work or by possession of the copyright through sale or transfer.<sup>24</sup> Registration of the work with the Register of Copyrights is *prima facie* evidence of the validity of the copyright,<sup>25</sup> but is not necessary to prove ownership by original cre-

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In many cases, the question may naturally turn upon the point, not so much of quantity, as of the value of the selected materials. As was significantly said on other occasions—"Non numerantur, ponderantur." The quintessence of a work may be piratically extracted, so as to leave a mere *caput mortuum*, by selection of all the important passages in a comparatively moderate space.

Gray v. Russell, 10 F. Cas. 1035, 1038 (C.C.D. Mass. 1839) (No. 5,728). A whole line of cases following the same reasoning appeared, several written by Judge Story. See *Folsom v. Marsh*, 9 F. Cas. 342 (C.C.D. Mass. 1841) (No. 4,901); *Emerson v. Davies*, 8 F. Cas. 615 (C.C.D. Mass. 1845) (No. 4,436); *Daly v. Palmer*, 6 F. Cas. 1132 (C.C.S.D.N.Y. 1868) (No. 3,552).

A more extensive review of the development of American copyright law is contained in B. KAPLAN, *AN UNHURRIED VIEW OF COPYRIGHT* (1967).

18. 1 M. NIMMER, *supra* note 3, at § 2.03[D].

19. 17 U.S.C. app. § 102(b) (1976).

20. N. BOORSTYN, *supra* note 3, at § 1:2.

21. 1 M. NIMMER, *supra* note 3, at § 2.03[D].

22. 3 M. NIMMER, *supra* note 3, at § 13.01; N. BOORSTYN, *supra* note 3, at § 10:10.

23. 3 M. NIMMER, *supra* note 3, at §§ 12.11[A], 12.11[D].

24. 3 M. NIMMER, *supra* note 3, at § 13.01[A]; N. BOORSTYN, *supra* note 3, at § 10:11.

25. 17 U.S.C. app. § 410(c) (1976).

ation.<sup>26</sup> A copyright may also be transferred from the original creator to another party, giving rise to ownership by third parties.<sup>27</sup>

Usually, there is little evidence to prove the actual copying of the prior work by the defendant.<sup>28</sup> Few, if any, witnesses to the act of copying can be found; therefore, the courts have devised a method for inferring copying. The plaintiff must prove two sub-elements to create this inference: access to the prior work and substantial similarity<sup>29</sup> between the two works.

Access is a threshold requirement necessary to invoke the inference of copying. Courts have assumed that copying cannot occur unless the defendant had an opportunity to view or read the prior work.<sup>30</sup> Once the sub-element of access has been proven, the plaintiff must fulfill the second requirement.<sup>31</sup>

Substantial similarity, the second sub-element, must exist between the two works before the inference of copying will arise.<sup>32</sup> The rationale for this requirement is a belief that copying of the prior work must not be trivial nor insubstantial.<sup>33</sup> It is here that the majority of problems occur, and the history of copyright law is replete with attempts to define and limit the concept of substantiality. These attempts often take the form of models or tests which may be applied by the court in arriving at a decision on infringement.

## B. The Abstractions Test

The main issue confronting most courts is the breadth of protection afforded the plaintiff's work.<sup>34</sup> In a copyright infringement action, a court must distinguish an idea from an expression because the general rule is that the second work may use the ideas of the prior work, but not the prior work's expressions.<sup>35</sup> The courts' "line-drawing" between the dispa-

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26. H.R. REP. NO. 1476, 94th Cong., 2d Sess. 129, reprinted in 1976 U.S. CODE CONG. & AD. NEWS 5659, 5745; 17 U.S.C. app. § 301 (1976). See also 3 M. NIMMER, *supra* note 3, at § 13.01[B].

27. 1 M. NIMMER, *supra* note 3, at §§ 5.01[A]-5.01[B].

28. Roth Greeting Cards v. United Card Co., 429 F.2d 1106, 1110 (9th Cir. 1970).

29. 3 M. NIMMER, *supra* note 3, at § 13.01[B]; N. BOORSTYN, *supra* note 3, at § 10:12.

30. 3 M. NIMMER, *supra* note 3, at § 13.02; N. BOORSTYN, *supra* note 3, at § 10:13.

31. *Id.*

32. 3 M. NIMMER, *supra* note 3, at § 13.03; N. BOORSTYN, *supra* note 3, at § 10:14.

33. Shipman v. R.K.O. Radio Pictures, Inc., 100 F.2d 533, 537 (2d Cir. 1938).

34. Krofft v. McDonald's, 562 F.2d at 1163.

35. 17 U.S.C. app. § 102(b) (1976) (excludes "idea" from copyright protection); Baker v. Selden, 101 U.S. 99 (1879).

rate concepts of idea and expression, however, is inherently vague and arbitrary. There is some suggestion that all such determinations are invariably ad hoc<sup>36</sup> and that judicial line-drawing is of limited utility.<sup>37</sup> To counter this suggestion, scholars and writers have devised numerous models to aid judges and juries in determining the interface between an idea and an expression.<sup>38</sup>

Judge Learned Hand proposed one of the first models in 1930.<sup>39</sup> Now called the "abstractions" test by modern courts, his theory, or model, presumed the existence of a continuum between ideas and expressions.<sup>40</sup> As Judge Hand envisioned it, the continuum was linear, with an idea pole and an expression pole diametrically opposed. The idea end of the continuum was general and non-descriptive, whereas the expression end was fraught with distinctive embellishment and creative ornamentation.<sup>41</sup> Hence, as one progressed from the idea pole to the expression pole, one encountered increasing complexity and intricacy.

If the abstractions test is applied to a copyrighted work, for example, a novel might be equated with a story outline, a synopsis or even a sentence.<sup>42</sup> Each of these forms has successive degrees of complexity, ranging from very simple to very complex. Between these disparate categories of simplicity and complexity lies a point at which one of the forms is too broad, too general or too vague and is therefore unprotectable.<sup>43</sup> Under Hand's test, as an expression becomes more "abstract," it loses the distinctiveness which makes it protectable.

The abstractions test has been criticized as merely restating the rule of expression protectability.<sup>44</sup> The test, say some critics, is not a test at all because it provides no guidance in sepa-

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36. *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (1960).

37. Sorensen & Sorensen, *Re-Examining the Traditional Legal Test of Literary Similarity: A Proposal for Content Analysis*, 37 CORNELL L.Q. 638 (1952).

38. See *infra* notes 39-60 and accompanying text.

39. *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930) (citing *Holmes v. Hurst*, 174 U.S. 82, 86).

40. An illustration of the idea/expression continuum is contained in Knowles & Palmieri, *Dissecting Krofft: An Expression of New Ideas in Copyright?*, 8 SAN FERN. V.L. REV. 109, 127 (1980).

41. *London v. Biograph Co.*, 231 F. 696, 698 (1916); see also Note, *supra* note 3, at 801 n.38.

42. 45 F.2d at 121.

43. 100 F.2d at 538 (Hand, J., concurring).

44. Knowles & Palmieri, *supra* note 40, at 119.

rating ideas from expressions.<sup>45</sup> In reality, note Hand's detractors, every court considers an idea an abstraction of an expression.<sup>46</sup> Therefore, the abstractions test does nothing more than provide a model of the idea/expression continuum and does not outline a methodology for determining the boundary of protectable expression.

### C. The Patterns Test

To that end, fifteen years after the abstractions test was proposed, Professor Zechariah Chafee, Jr. wrote a monograph on the law of copyright within which he observed that infringement occurs when a prior work's essential "pattern" or sequence of events is similarly recounted by a second author.<sup>47</sup> He defined a pattern as a series of abstractions arranged temporally or chronologically.<sup>48</sup> Professor Melville Nimmer once compared the abstractions of *Romeo and Juliet* to the abstractions of *West Side Story* by chronologically selecting similar events from both works.<sup>49</sup> He concluded that the two works were substantially similar under the patterns test due to thirteen coincident elements in both stories.<sup>50</sup> It is essential to note that each element is not necessarily dependent on another element insofar as chronological arrangement is concerned.

A second definition of a pattern is as a fixed arrangement of events or occurrences.<sup>51</sup> A common, banal pattern, for example, might be: boy meets girl, boy marries girl, boy and girl have a family, etc. The difference between this approach and the preceding approach is that in the former, chronology is a by-product, whereas in the latter, each event is interdependent on other events. Under either construction, infringement occurs when the pattern in the prior work identically corresponds to the pattern in the second work.<sup>52</sup>

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45. Note, "Expression" and "Originality" in Copyright Law, 11 WASHBURN L.J. 400, 406 (1972); see also Knowles & Palmieri, *supra* note 40.

46. See *supra* note 45.

47. Chafee, *Reflections on the Law of Copyright I*, 45 COLUM. L. REV. 503, 513 (1945).

48. *Id.* at 514.

49. 3 M. NIMMER, *supra* note 3, at § 13.03[A]. Cf. Knowles & Palmieri, *supra* note 40, at 149 (the authors reach the opposite conclusion using the patterns test).

50. 3 M. NIMMER, *supra* note 3, at § 13.03[A][1].

51. E.g., *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 55-56 (2d Cir. 1936).

52. See 3 M. NIMMER, *supra* note 3, at § 13.03[A]; Note, *Copyright: Hollywood v. Substantial Similarity*, 32 OKLA. L. REV. 177 (1979).



The patterns test has been acknowledged in numerous articles and treatises since its creation.<sup>53</sup> As commentators have perceived it, the foundation for the patterns test rests on a belief that the pattern of a work is integral to its expression. It is thought that an author fashions a unique arrangement of ideas from among myriad permutations and that therefore he or she is entitled to copyright protection.<sup>54</sup> A corollary to this belief is the idea that if the patterns of two works are substantially similar, then copying must have occurred.<sup>55</sup>

The patterns test, however, is not without its detractors. One criticism of the patterns test is that it is a glorified version of the abstractions test.<sup>56</sup> A pattern might be considered a complex abstraction, much like a detailed outline, which approximates the line between idea and expression better than a simple abstraction.<sup>57</sup> Another criticism is that the patterns test provides no more guidance than the abstractions test.<sup>58</sup> Critics note that neither test establishes standards for differentiating an expression from an idea, leaving juries and judges few solutions in resolving this key issue.<sup>59</sup>

In support of the abstractions and the patterns tests, proponents have argued that the tests aid laymen in recognizing the distinctions between ideas and expressions and that more restrictive models will lack enough flexibility to accommodate the variety of artistic and literary works.<sup>60</sup> To some extent these supporting arguments are valid. Juries and judges often rely on theoretical models when deciding complex and intricate issues.<sup>61</sup> At least, both the patterns test and the abstractions test formalize the idea/expression distinction. At most, the

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53. See 3 M. NIMMER, *supra* note 3, at § 13.03[A]; Berman & Boxer, *supra* note 4, at 318; Knowles & Palmieri, *supra* note 40, at 136; Note, *supra* note 51, at 187.

54. *Dymow v. Bolton*, 11 F.2d 690, 691 (2d Cir. 1926).

55. See Nimmer, *Inroads on Copyright Protection*, 4 COPYRIGHT L. SYMP. (ASCAP) (1952).

56. See Knowles & Palmieri, *supra* note 40, at 136; Sorensen & Sorensen, *supra* note 37.

57. See Note, *supra* note 51, at 189.

58. See Sorensen Sorensen, *supra* note 37, at 642.

59. Despite these criticisms, the patterns test has been used recently in *Reyher v. Children's Television Workshop*, 533 F.2d 87, 91 (2d Cir. 1976), and *Musto v. Meyer*, 434 F. Supp. 32, 35-36 (S.D.N.Y. 1977). The abstractions test can be found in *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738 (9th Cir. 1971), and *Burnett v. Lambino*, 204 F. Supp. 327, 332-334 (S.D.N.Y. 1962).

60. 3 M. NIMMER, *supra* note 3, at § 13.03[A][1].

61. *E.g.*, the doctrine of *res ipsa loquitur* might be considered an aid for judges and juries, W. PROSSER, *THE LAW OF TORTS* 211-235 (4th ed. 1971).

tests provide a method of comparing two works in a relatively uncomplicated manner so that juries and judges can deal with the complex issue of copyright infringement. So far, courts have been unwilling to interpret strictly the concepts of idea and expression, fearing that future forms of expression could be denied protection.

#### D. The *Krofft* Process

The Ninth Circuit has chosen a different approach to avoid the Procrustean bed between vague standards and restrictive construction. In *Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp.*,<sup>62</sup> the court set forth a two-fold process to determine substantial similarity.<sup>63</sup> It is important to recognize that the *Krofft* process does not supersede the abstractions and patterns tests. Rather, it is a procedural device designed to aid courts in resolving the issue of substantial similarity. The abstractions test and the patterns test are still invaluable tools in measuring the extent of copyright protection. *Krofft* merely specifies the timing of their application. The goal of the *Krofft* court was to promulgate a more objective and accurate procedure in hopes of eradicating confusion about copyright protection.<sup>64</sup>

The methodology of *Krofft* is best described as a process toward finding substantial similarity. The first step, called the extrinsic test, is a determination of the similarity of ideas between the two works.<sup>65</sup> *Krofft* assumes that there can be no similarity of expression without some similarity of idea. Therefore, the extrinsic test is a threshold issue which demands a significant showing of similarity of idea.<sup>66</sup> This step is intended to be a finding made by a judge, and dissection, or expert testimony on the differences and similarities in both works, is appropriate at this stage.<sup>67</sup>

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62. 562 F.2d 1157 (9th Cir. 1977).

63. The process is essentially a "reduction to practice" outlined in an earlier case, *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946), *cert. denied*, 330 U.S. 851, 67 S. Ct. 1096 (1947). See also 3 M. NIMMER, *supra* note 3, at § 13.03[E] [3]; N. BOORSTYN, *supra* note 3, at § 10:14.

64. Knowles & Palmieri, *supra* note 40, at 131-133; Note, *Copyright Infringement Actions: The Proper Role for Audience Reactions in Determining Substantial Similarity*, 54 S. CAL. L. REV. 385, 410 (1981); Note, *supra* note 51, at 183.

65. 562 F.2d at 1162. See also Knowles & Palmieri, *supra* note 40, at 132.

66. 3 M. NIMMER, *supra* note 3, at § 13.03[E] [3]; Knowles & Palmieri, *supra* note 40, at 132; Note, *supra* note 51, at 184.

67. 562 F.2d at 1164.

Once the court is convinced the extrinsic test has been satisfied, the issue of substantial similarity proceeds to the resolution of the similarity of expression, called the intrinsic test.<sup>68</sup> This second step encompasses a finding made by the trier of fact, usually a jury, and uses the "ordinary lay observer" standard.<sup>69</sup> Under the ordinary lay observer standard, the trier of fact must find that the average viewer or reader believes the two works to be substantially similar in expression.<sup>70</sup> Only a similarity sufficient to infer copying, not actual confusion of origin,<sup>71</sup> need be found. The *Krofft* opinion indicated that dissection is inappropriate at this stage because it is unnecessary under the ordinary lay observer standard.<sup>72</sup>

Although the reasoning of *Krofft* has been followed in the Ninth Circuit<sup>73</sup> and has been cited in other circuits,<sup>74</sup> one writer has criticized the process because it does not eradicate the peculiarities and problems of the ordinary lay observer standard, such as the relative unsophistication of juries confronted with unfamiliar media.<sup>75</sup> Other critics fear that there will be fewer reversals at the appellate level because judges frequently reach a finding of similarity of idea, thus satisfying the extrinsic test.<sup>76</sup> A jury usually renders the finding of similarity of expression, creating a difficult obstacle to overcome at the appellate level. Appellate courts are reluctant to tamper with lower court findings unless there is a clear error on which reasonable minds may not differ.<sup>77</sup> Finally, much criticism fo-

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68. *Id.*

69. Knowles & Palmieri, *supra* note 40, at 120. See generally Note, *supra* note 64.

70. See Note, *supra* note 64, at 389-391.

71. "Confusion of origin" is a trademark concept. It has had some utility, and misuse, in cases on the fringe of copyright law, e.g., *International News Service v. Associated Press*, 248 U.S. 215, (1918) (copyright protection unavailable for news stories).

72. 562 F.2d at 1164 (citing *Twentieth Century-Fox Film Corp. v. Stonesifer*, 140 F.2d 579, 582 (9th Cir. 1944)).

73. *Twentieth Century-Fox Film Corp. v. MCA, Inc.*, 209 U.S.P.Q. (BNA) 200 (C.D. Cal. 1980), *aff'd mem.*, No. 78-2437 (9th Cir. May 8, 1981); *Walker v. University Books, Inc.*, 602 F.2d 859 (9th Cir. 1979).

74. *O'Neill v. Dell Publishing Co.*, 630 F.2d 685 (1st Cir. 1980); *Dallas Cowboys Cheerleaders v. Scoreboard Posters*, 600 F.2d 1184 (5th Cir. 1979); *Franklin Mint Corp. v. Nat'l Wildlife Art Exch.*, 595 F.2d 62 (3rd Cir. 1978); *MGM, Inc. v. Showcase Atlanta Co-op. Prod., Inc.*, 479 F. Supp. 351 (N.D. Geo. 1979); *Ideal Toy Corp. v. Kenner Products, Inc.*, 443 F. Supp. 291 (S.D.N.Y. 1977).

75. See Note, *supra* note 64.

76. 562 F.2d at 1164 (citing *International Luggage Registry v. Avery Products Corp.*, 541 F.2d 830 (9th Cir. 1976); *Caddy-Imler Creations, Inc. v. Caddy*, 299 F.2d 79 (9th Cir. 1962)). See also 3 M. NIMMER, *supra* note 3, at § 13.03[E].

77. F. JAMES & G. HAZARD, *CIVIL PROCEDURE* § 13.8 (2d ed. 1977).

cuses on *Krofft*'s elimination of dissection in the intrinsic stage, which allows no expert testimony before the trier of fact.<sup>78</sup> It has been argued that juries cannot arrive at sound conclusions without expert testimony, particularly in areas such as music, where the average juror has only a modicum of expertise.<sup>79</sup> By sanitizing the evidence before the jury, decisions might be rendered on "gut reaction" alone.

*Krofft* is a relatively recent decision and it is too early to tell whether these problems will arise. No case using *Krofft* has gone to a jury because judges carefully scrutinize evidence at the extrinsic stage, especially on motions for summary judgment.<sup>80</sup> Hence, cases rarely proceed past the extrinsic step unless there is a good probability that a jury will find similarity of expression. Courts which have adopted *Krofft*, or some similar version, have indicated that a summary of similarities and differences in both works may go to the trier of fact.<sup>81</sup> This limited form of dissection is not obligatory, but at least may allow a jury access to testimony by experts regarding other infringement theories.

The value of *Krofft* is unknown at this time and more cases adhering to the rationale of *Krofft* must be decided before substantial weight can be given to the process. Courts which have used the *Krofft* process, however, have been willing to assume the validity of the procedure and have adapted the process in deciding issues of substantial similarity.<sup>82</sup>

### III

#### The *Scènes à Faire* Doctrine

In 1945 Judge Leon Yankwich of the U.S. District Court in California proposed another theory of copyright protection. His opinion in *Schwarz v. Universal Pictures Co.*<sup>83</sup> used the French phrase "*scènes à faire*" to describe non-copyrightable

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78. Note, *supra* note 64, at 413. See also 3 M. NIMMER, *supra* note 3, at § 13.03[E].

79. See Note, *supra* note 64.

80. See, e.g., *Twentieth Century-Fox Film Corp. v. MCA, Inc.*, 209 U.S.P.Q. (BNA) 200 (C.D. Cal. 1980). See *infra* note 144.

81. E.g., *Ideal Toy Corp. v. Kenner Products, Inc.*, 443 F. Supp. 291 (S.D.N.Y. 1977) (the court said that a brief summary of the similarities and differences between both works may be given to the trier of fact).

82. See *supra* note 74 for cases using the *Krofft* test.

83. 85 F. Supp. 270 (S.D. Cal. 1945). Judge Leon Yankwich was a competent scholar on the law of copyright and wrote extensively on the concept of protectability of expressions. See Yankwich, *supra* note 6.

material in original works.<sup>84</sup> *Scènes à faire*, as Judge Yankwich described them, are "scenes which 'must' be done,"<sup>85</sup> or alternatively, scenes which are so integral to the plot or theme that they arise as a natural consequence of an artist's expression.

Judge Yankwich explains the doctrine in this way:

These cases indicate that when you are dealing with a common idea, no matter how different the treatment may be, common elements will appear in both products. In so far as these common elements are distinct, they amount to creative originality. And, in so considering them, the similarities which are traceable to the common sources are disregarded. But similarities may appear which are inherent in a situation. The French refer to them as *scènes à faire* . . .<sup>86</sup>

In a later monograph, Judge Yankwich reiterated the *scènes à faire* doctrine and his reasoning in *Schwarz*. After reviewing the traditional methods courts have used to distinguish ideas from expressions, he concluded that practical application created finer distinctions than traditional methods.<sup>87</sup> There was not, as had been suggested earlier, a vast difference between idea and expression, for sometimes plot devices contained characteristics of both. He noted that certain situational requirements of a plot often demand that scenes be similar. The *scènes à faire* doctrine, therefore, was intended to protect an author whose work had similar elements of an earlier work because specific scenes demanded those similarities.<sup>88</sup>

The facts of *Schwarz* are helpful in explaining the *scènes à faire* doctrine. In one of the works at issue there was a scene in which a girl's hand is marked by a burn. The scene was necessary for the purpose of identification. Once this situation had been created, it was also necessary to create other scenes explaining the burn. The second work had similar scenes explaining an identifying mark.<sup>89</sup> Judge Yankwich said that the similar scenes were a natural and necessary consequence of the earlier identification scene.<sup>90</sup> Consequently, an author

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84. 85 F. Supp. at 275.

85. *Id.* The literal translation is more accurately "scenes to be done."

86. Yankwich, *supra* note 6, at 462.

87. *Id.* at 461.

88. *Id.* at 462-463.

89. 85 F. Supp. at 275.

90. *Id.*

could not infringe scenes which “*had to be resorted to*”<sup>91</sup> by using them in his own work.

*Scènes à faire* might be analogized to a row of dominoes, each domino representing an idea or an abstraction. Once one domino falls, the rest must necessarily fall as well. Therefore, once an idea is used, other ideas must naturally fall into place as a result. The *scènes à faire* doctrine was intended to insulate an author who uses a set of ideas stemming from one idea. Judge Yankwich devised the doctrine because he realized how easy it was to mistake the use of *scènes à faire*, the set of dominoes, for plagiarism.<sup>92</sup>

The doctrine has never been used alone in justifying a finding of non-infringement by a second author. In the past decade, however, the number of cases employing the *scènes à faire* argument has increased significantly.<sup>93</sup> Defendants use the *scènes à faire* doctrine as an additional weapon among a panoply of defenses to an allegation of copyright infringement.<sup>94</sup> Unfortunately, this trend has led to protection of potentially infringing works.

#### A. Historical Works

A recent example of this disturbing trend is *Alexander v. Haley*,<sup>95</sup> in which the book *Roots*, by Alex Haley, was found not to infringe an earlier work, the book *Jubilee*. Both books contained identical references to historical folkways and “stock” events.<sup>96</sup> The district court referred to the *scènes à faire* doctrine in holding that the common incidents, characters and settings were indispensable to any treatment of the topic of slavery.<sup>97</sup> Citing earlier cases,<sup>98</sup> the court reiterated

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91. Yankwich, *supra* note 6, at 463.

92. *Id.* at 462-465.

93. See *supra* notes 9-10.

94. *E.g.*, Twentieth Century-Fox Film Corp. v. MCA, Inc., 209 U.S.P.Q. (BNA) 200 (C.D. Cal. 1980).

95. 460 F. Supp. 40, 200 U.S.P.Q. (BNA) 239 (S.D.N.Y. 1978).

96. *Id.* at 45, 200 U.S.P.Q. (BNA) at 243.

97. Among the examples of *scènes à faire* were: sex between male slaveowners and female slaves and the consequent resentment of the female slave owners (*Jubilee*, at 44, *Roots*, at 436); the sale of a slave child away from her family and the attendant agonies (*Jubilee*, at 84-85, *Roots*, at 424-426); the horror of punitive mutilation (*Jubilee*, at 114, *Roots*, at 224); and slave owners complaining about the high price of slaves (*Jubilee*, at 113, *Roots*, at 397). *Alexander v. Haley*, 460 F. Supp. at 45 n.7, 200 U.S.P.Q. (BNA) at 243 n.7. An example of the similarities in both works is found in PUBLISHERS WEEKLY, May 2, 1977, at 20.

98. *Reyher v. Children's Television Workshop*, 533 F.2d 87 (2d Cir. 1976); *Fuld v.*

that the *scènes à faire* in question were ideas, not expressions, and therefore were unprotected by copyright.

Using the earlier domino analogy, the court in *Alexander* might have reasoned that the idea of slavery was the first domino to topple, setting the other *scènes à faire* into motion. In this case, the scenes of interracial sex, mutilation and child abduction were deemed necessary to the exposition of the slavery theme.<sup>99</sup> Therefore, reasoned the court, Alex Haley's use of these scenes did not infringe similar scenes in *Jubilee*.

A factor which might have affected the *Alexander* court's decision is the fact that the two works had some historical or factual basis.<sup>100</sup> In general, courts have granted protection to historical works, but have not extended this protection to facts or other non-fictional information contained in these works. Fearing that the policy of encouraging contributions to the public domain is stymied by such protection, courts have allowed defendants to use descriptions and scenarios only tangentially related to historical fact.<sup>101</sup> *Alexander* affirms the principle that even fictional works based on historical facts cannot infringe the non-fictional part of a prior work.<sup>102</sup>

## B. Fictional Works

Fictional works can also fall under the rubric of *scènes à faire*, if it can be shown that the *scènes à faire* are distinct motifs or events associated with a specific genre. These genres or types, such as the Western or horror story, are considered by courts to be a part of the larger body of ideas.<sup>103</sup> Therefore, fictional works may also contain *scènes à faire*.

A current example is *Twentieth Century-Fox Film Corp. v. MCA, Inc.*,<sup>104</sup> a case dealing with the purported infringement of

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National Broadcasting Co., 390 F. Supp. 877 (S.D.N.Y. 1975); *Greenbie v. Noble*, 151 F. Supp. 45 (S.D.N.Y. 1957); *Warshawsky v. Carter*, 132 F. Supp. 758 (D.D.C. 1955).

99. 460 F. Supp. at 45, 200 U.S.P.Q. (BNA) at 243.

100. See *Miller v. Universal City Studios, Inc.*, 650 F.2d 1365 (5th Cir. 1981); *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972 (2d Cir. 1980); *Rosemont Enter., Inc. v. Random House, Inc.*, 366 F.2d 303 (2d Cir. 1966), *cert. denied*, 385 U.S. 1009, 87 S. Ct. 714 (1967).

101. 618 F.2d at 980.

102. Both the book *Roots* and the book *The Hindenburg* in *Alexander v. Haley* and *Hoehling v. Universal City Studios, Inc.*, respectively, were considered fictional accounts based on real events.

103. *E.g.*, 209 U.S.P.Q. (BNA) at 207-208.

104. 209 U.S.P.Q. (BNA) 200 (C.D. Cal. 1980), *aff'd mem.*, No. 78-2437 (9th Cir. May 8, 1981).

the motion picture "Star Wars" by the television series "Battlestar Galactica."<sup>105</sup> The district court did not base its decision on the *scènes à faire* doctrine<sup>106</sup> but mentioned it and granted summary judgment for the defendant.<sup>107</sup> In a counterclaim alleging that "Star Wars" infringed a prior science fiction film owned by the defendant, MCA, the circuit court used the *scènes à faire* rationale to deny copyright protection for the expression of a small robot.<sup>108</sup> In both opinions, no protection was given to the elements of a science fiction drama because they were, in the opinions of both courts, stock motifs of the genre.<sup>109</sup> The courts reasoned that, in comparing the separate elements individually, a subsequent work does not infringe a prior work if only *scènes à faire* have been appropriated.

### C. Definitional Problems

The application of the *scènes à faire* doctrine to the facts of a case presents several difficulties. The first is that although this judge-made concept is a convenient sobriquet for the idea/expression distinction, it actually goes beyond mere protection of potential infringers. The emphasis of prior theories has been on the act of copying by the infringer. The focus has been on the relationship between the two works, i.e., was the second work a result of the first work. The *scènes à faire* doctrine shifts this focus to include auxiliary factors such as the public's concept of ideas and the ability of the reader or viewer to notice alterations.<sup>110</sup>

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105. There was substantial evidence that the public considered the two works to be similar. Two national weekly magazines did extensive stories prior to the premiere of "Battlestar Galactica." *Small-Screen Star Wars: Battlestar Galactica seems strangely familiar*, TIME, Sept. 18, 1978, at 98; *TV Blasts Off*, NEWSWEEK, Sept. 11, 1978, at 58. Both magazines mentioned the suit brought by Twentieth Century-Fox.

106. 209 U.S.P.Q. (BNA) at 207. For more insight into the science fiction genre see J. BAXTER, SCIENCE FICTION IN THE CINEMA (1970).

107. 200 U.S.P.Q. (BNA) at 201.

108. The memorandum opinion of the appellate court dealt only with the counterclaim of MCA against Twentieth Century-Fox. This counterclaim alleged that the "Star Wars" android infringed a similar robot in MCA's earlier film "Silent Running."

109. An article in TIME, May 30, 1977, compared scenes and motifs from "Star Wars" with other films, such as "The Wizard of Oz" and "Thirty Seconds Over Tokyo." The film critic Audie Bock had suggested that "Star Wars" was influenced by Akira Kurosawa's "The Hidden Fortress," A. Bock, Film Notes for the Japanese Film Festival, Sherman Theatre, Sherman Oaks, California (Oct. 12, 1979).

110. This is particularly true when the second work is a parody or satire of the prior work. In Warner Bros., Inc. v. ABC, Inc., 654 F.2d 204 (2d Cir. 1981), the district court judge mentioned the *scènes à faire* doctrine, but concluded that "The Greatest American Hero" was a parody of "Superman, The Movie" and therefore protected under the



It is widely recognized that minute alterations of expressions in a prior work will not be afforded protection.<sup>111</sup> By the very definition of the *scènes à faire* doctrine, when a second author uses a *scène à faire*, he is using an idea from a prior work. The second author must alter the description slightly because he cannot take the expression verbatim. This altered form may seem like a new expression, but still be substantially similar. The copier incurs no liability, however, because the idea is understood to be unprotectable.<sup>112</sup>

The major problem with the *scènes à faire* doctrine, however, arises from the lack of judicial standards and limitations on the doctrine.<sup>113</sup> Being a relatively inchoate theory, the *scènes à faire* doctrine has been only cursorily defined and superficially scrutinized.<sup>114</sup> Very little guidance has been provided by the courts as to what constitutes a genre or theme worthy of protection. The courts, for example, have never indicated when the science fiction genre came into being.<sup>115</sup> The genre's literary roots may be traced to Jules Verne or H.G. Wells, but might even encompass the works of Melville.<sup>116</sup>

As is the case with many copyright infringement cases, the dividing line between idea and expression seems clear when applied to the facts of the case, but becomes obfuscated when applied to other fact situations.<sup>117</sup> It may be relatively easy to conclude that a robot is a common "character" in a science fiction film<sup>118</sup> but similar conclusions are difficult to reach when applied to sword fights, barroom shootouts and rebellion

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fair use doctrine. This conclusion was drawn despite the use of similar costumes, incidents and settings. *Accord Benny v. Loew's, Inc.*, 239 F.2d 532 (9th Cir. 1956).

111. *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121, *cert. denied*, 282 U.S. 902, 51 S. Ct. 216 (1930); 18 C.J.S. *Copyright and Literary Property* § 94 (1939).

112. 618 F.2d at 979-980.

113. The problem is not confined to the judicial arena but is found in the area of film criticism, as well. *See A. SARRIS, THE AMERICAN CINEMA* 30 (1968).

114. Since 1945, when Judge Yankwich applied the phrase "*scènes à faire*" to copyright infringement actions, there have been only eight cases which have mentioned the doctrine by name. *See supra* note 9.

115. Judge Hill's comment in *Twentieth Century-Fox* that the space/fantasy genre was too new to form a foundation for infringement is characteristic of the problem. 209 U.S.P.Q. (BNA) at 207. One film critic has examined the genre concept and found that it changes with the social patterns of the times. He contends that genres are rarely fixed and unchanging. *See S. KAMINSKY, AMERICAN FILM GENRES* (1977).

116. J. BAXTER, *supra* note 106, at 7-13, 208-209.

117. *E.g.*, *Ideal Toy Corp. v. Kenner Products, Inc.* 443 F. Supp. 291 (S.D.N.Y. 1977).

118. Brief of Appellee at 16-17, *Twentieth Century-Fox Film Corp. v. MCA, Inc.*, 209 U.S.P.Q. (BNA) 200 (C.D. Cal. 1980) (quoting Arthur Knight, professor of cinema at the University of Southern California and film critic).

among the oppressed.<sup>119</sup> "Star Wars" contained all of these elements, but the last three could easily be found in Westerns, sword-and-sorcery epics or documentaries.

Many judges who have agreed with the *scènes à faire* doctrine have also assumed that their view of genres or themes is in concordance with the average lay observer's viewpoint.<sup>120</sup> There have been some suggestions that this notion is incorrect and that popular sentiment and opinion have been ignored.<sup>121</sup> By definition, a genre or motif comes into existence by public recognition and acceptance of that genre or motif.<sup>122</sup> But no court has indicated the origin of its *scènes à faire*, other than a tacit assumption that the public recognizes the ideas shared by the two works in question.<sup>123</sup>

Besides a lack of definitional guidance on the *scènes à faire* doctrine, there are some policy considerations which are circumvented by the doctrine.<sup>124</sup> In the case of historical works, for example, the efforts of authors in their compilation and research is negated by the *scènes à faire* doctrine.<sup>125</sup> Unless there is verbatim copying, the *scènes à faire* doctrine allows the products of research to be copied with impunity. There are a few cases which suggest that individual effort in ferreting out information on historical events should not be denied protection.<sup>126</sup> But the gist of the opinions is that the research must affect the expression, and the courts inevitably center on the blatant nature of the copying to justify its findings.<sup>127</sup>

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119. An example of the lack of judicial clarity can be found in *Alexander v. Haley*. Judge Frankel distinguished historical facts, customs and *scènes à faire*. Is there really a difference, as far as the idea/expression distinction is concerned, between manumission (historical fact), cockfighting (custom) and punitive mutilation of slaves (*scènes à faire*)? The court offered few guidelines as to how to categorize scenes and situations. 460 F. Supp. at 45 nn.5-7, 200 U.S.P.Q. (BNA) at 242-243 nn.5-7. The court in *Hoehling v. Universal City Studios* recapitulated the same process, dividing the incidents into three categories: themes, facts and *scènes à faire*. 618 F.2d at 979-980.

120. 209 U.S.P.Q. (BNA) at 207.

121. Note, *supra* note 64, at 386.

122. "Genre. A recognizable type of film which depends on certain established conventions." L. GIANNETTI, *UNDERSTANDING MOVIES* 457 (1976) (emphasis added).

123. See *supra* note 105.

124. Note, *supra* note 51, at 179.

125. E.g., *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972 (2d Cir. 1980); *Alexander v. Haley*, 460 F. Supp. 40, 200 U.S.P.Q. (BNA) 239 (S.D.N.Y. 1978).

126. See *Toksvig v. Bruce Publishing Co.*, 181 F.2d 664 (7th Cir. 1950); *Leon v. Pacific Telephone & Telegraph Co.*, 91 F.2d 484 (9th Cir. 1937); *H.C. Wainwright & Co. v. Wall Street Transcript Corp.*, 418 F. Supp. 620 (S.D.N.Y. 1976); *Huie v. National Broadcasting Co.*, 184 F. Supp. 198 (S.D.N.Y. 1960).

127. A prerequisite to a finding of infringement by copying an historical work is that

Another damaging aspect of the *scènes à faire* doctrine is that it shifts the burden of proof back to the plaintiff.<sup>128</sup> If the defendant raises the defense of *scènes à faire*, then the plaintiff must show that the infringed scenes are protected by copyright. Traditionally, once the plaintiff has shown access and substantial similarity, the burden shifts to the defendant to prove independent creation.<sup>129</sup> With the *scènes à faire* doctrine as an affirmative defense, the burden of proof shifts back to the plaintiff to show that his or her expressions were copied.<sup>130</sup> As a result, the plaintiff must overcome this additional obstacle by providing more evidence indicating that his or her expressions are separable from ideas.<sup>131</sup> This evidence may come in the form of more expert testimony or stronger extrinsic evidence of copying. At any rate, the plaintiff's case is weakened if no such evidence exists or is unavailable.

In conclusion, judges have not provided enough guidance on the definition of the *scènes à faire* doctrine and on how the doctrine should be applied.

#### IV

#### Conflicts with Other Models

Besides the definitional problems attendant to the *scènes à faire* doctrine, there are irreconcilable differences between the doctrine and the abstractions and patterns tests. These differences add undue complexity to the area of copyright infringement and result in capricious decisions by the courts. The abstractions test and the patterns test represent accepted models of copyright protection and provide uniformity and guidance to the courts. In addition, the *Krofft* process aids courts by formalizing the method of examining the issue of infringement. Because the *scènes à faire* doctrine narrows the scope of copyright protection, it creates inherent conflicts with the other tests and models. As a result, the benefits gained by the development of the traditional methods of copyright protection

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the alleged copier must not have done any independent research to arrive at the same facts. 184 F. Supp. at 200. Cf. *Hoehling v. Universal City Studios, Inc.*, 618 F.2d at 979 (citing *Rosemont Enterprises, Inc. v. Random House, Inc.*, 366 F.2d 303 (2d Cir. 1966)).

128. The burden of proof is always upon the plaintiff to prove access and copying. See 3 M. NIMMER, *supra* note 3, at § 12.11[D]; N. BOORSTYN, *supra* note 3, at § 10:12.

129. See 3 M. NIMMER, *supra* note 3, at § 12.11[D]. E.g., *John L. Perry Studio, Inc. v. Wernick*, 597 F.2d 1308 (9th Cir. 1979).

130. 209 U.S.P.Q. (BNA) at 207.

131. See M. NIMMER, *supra* note 3, at § 12.11[D].

are eliminated because the *scènes à faire* doctrine cannot be reconciled with these methods.

#### A. Conflicts with the Abstractions Test

At first glance, a layman might view the *scènes à faire* doctrine as an interpretation of the abstractions test, especially if he equates a *scène à faire* with an unprotectable expression.<sup>132</sup> Originally, *scènes à faire* were defined as ideas. Recently, however, courts have misconstrued the intent of the doctrine and have applied the doctrine to abstractions which might merit protection.

A case in point is the court of appeals' discussion of robots in *Twentieth Century-Fox*. The three robots at issue were small, mobile androids which were capable of organic responses.<sup>133</sup> If the court had applied the abstractions test, it would have examined each android separately and winnowed away the distinctive attributes and embellishments unique to each robot. When the court had arrived at the most abstract, but still protectable, description, then it could have compared the two to determine the issue of copying by the defendant. If the descriptions were substantially similar, then there would be a finding of infringement. Instead, the court used the *scènes à faire* doctrine and reasoned that the *idea* of a robot was an unprotectable *scène à faire* and that therefore any conception or expression of that idea was similarly unprotectable.<sup>134</sup>

This result stems from an error in logic on the part of the court. The idea of a robot is free for use by anyone, but two expressions of that idea may still infringe each other. The court erred by reversing the argument, reasoning that if an

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132. If, as the cases claim, *scènes à faire* are ideas, then they might be considered abstractions which are not sufficiently "concrete" to warrant protection. See Yankwich, *supra* note 6, at 462.

133. A copious dissection of the differences between the robots in "Star Wars" and "Silent Running" is contained in Appellant's Opening Brief at 18-21, *Twentieth Century-Fox Film Corp. v. MCA, Inc.*, 209 U.S.P.Q. (BNA) 200 (C.D. Cal. 1980).

134. The Ninth Circuit stated it plainly in its memorandum opinion. "The district court found alternatively that there was no substantial similarity in *idea* or expression between the *Silent Running* and *Star Wars* robots." *Twentieth Century-Fox Film Corp. v. MCA, Inc.*, No. 79-3342, mem. op at 3 (9th Cir. May 8, 1981) (emphasis added).

The footnote to the quote above can be found in note 135, *infra*. This clearly shows that the appellate court considered the idea of a robot as equivalent to the expression of a robot, so far as protection was concerned. The court reasoned that because the "idea of a small robot in a science fiction setting" is unprotectable, then any expression connected with that idea would also be unprotectable. The court failed to realize that one can have a protectable expression originating with an idea.

idea is unprotectable, then any expression, other than a verbatim one, would also be unprotectable.<sup>135</sup> This misleading of the *scène à faire* doctrine is even more troublesome in light of the facts of *Twentieth Century-Fox*. Testimony in the case indicated that there have been various differing expressions of a robot throughout the history of film.<sup>136</sup> MCA, in its reply brief, listed several similarities particular to the robots in question, but which were not particular to any other robot in earlier films.<sup>137</sup>

Clearly, there were several noticeable similarities between MCA's and Twentieth Century-Fox's expression of a robot,<sup>138</sup> but the *scènes à faire* doctrine effectively shielded Twentieth Century-Fox's expression. Under the abstractions test, the similarities would have been evident because the descriptions would not have been "abstract" enough. The *scènes à faire* doctrine, however, denied protection to the first expression, allowing a second author to make substantial use of the distinctive attributes of the first robot.

## B. Conflicts with the Patterns Test

The *scènes à faire* doctrine has a strong conflict with the patterns test. In an earlier section, a pattern was described as having two types: a chronological array of scenes or an interdependent series of events.<sup>139</sup> The latter type of pattern presents an untenable conflict with the *scènes à faire* doctrine because one protects expressions, whereas the other denies protection.

In *Alexander*, for example, one event was the mutilation of a character as punishment for escaping.<sup>140</sup> This event may be defined as a pattern which is interrelated to earlier events,

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135. The Ninth Circuit noted: "To the extent that both the Universal and Fox characters in question embody the *idea* of a small robot in a science fiction setting, they are not protectable." *Twentieth Century-Fox Film Corp. v. MCA, Inc.*, No. 79-3342, mem. op. at 3 n.4 (9th Cir. May 8, 1981) (emphasis added). This conclusion was reached in spite of the convincing argument proposed by MCA/Universal in its reply brief. See Appellant's Reply Brief at 11-12, *Twentieth Century-Fox Film Corp. v. MCA, Inc.*, 209 U.S.P.Q. (BNA) 200 (C.D. Cal. 1980).

136. Brief of Appellee at 16-17, *Twentieth Century-Fox Film Corp. v. MCA, Inc.*, 209 U.S.P.Q. (BNA) 200 (C.D. Cal. 1980).

137. Appellant's Reply Brief at 11-12, *Twentieth Century-Fox Film Corp. v. MCA, Inc.*, 209 U.S.P.Q. (BNA) 200 (C.D. Cal. 1980).

138. *Id.*

139. See *supra* notes 46-50 and accompanying text.

140. 460 F. Supp. at 45-46.

such as a scene depicting the capture and bondage of the character before mutilation. The court, however, classified this scene under the *scènes à faire* doctrine, arguing that any treatment of slavery might contain this stock treatment of brutality towards slaves because it related to the larger theme of slavery.<sup>141</sup> If this scene had been considered a pattern, then it would have been protected by the patterns test. Instead, the court held that no infringement had occurred because the scene was protected by the *scènes à faire* doctrine.

The key here is the interrelationship of the events in both works. The patterns test was intended to protect these interrelated patterns and offer protection to the creator of the pattern. On the other hand, it is clear that Judge Yankwich wanted to put these interrelated patterns in the public domain.<sup>142</sup>

Again using the domino analogy, a pattern of the second type is like a row of dominoes. For the other scenes to fall into motion, there must be a initial event which sets them off. The patterns test would protect this arrangement of "dominoes," whereas the *scènes à faire* doctrine would insulate the infringer of the pattern.

### C. Conflicts with the *Krofft* Process

It seems evident that the *scènes à faire* doctrine is difficult to reconcile with two major theories of copyright protection. But even if the doctrine could be a reasonable theory standing alone, it has several potential conflicts with the *Krofft* process.

*Twentieth Century-Fox Film Corp.* is an illustrative example. At the district court level, in dealing with the first claim involving "Star Wars" and "Battlestar Galactica," the defendants were granted summary judgment.<sup>143</sup> The district court judge concluded that there was no similarity of idea between the two works when viewed as a whole. Thus, the extrinsic test was not satisfied.<sup>144</sup> If the judge had applied the *scènes à faire* doctrine, the case would have had to proceed to the intrinsic test stage. A finding by the judge that the defendant employed *scènes à faire* in his work would necessitate proceeding to the next step because the judge would have found as a matter of law that there was a similarity of ideas between the two

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141. *Id.*

142. See Yankwich, *supra* note 6, at 461-465.

143. 209 U.S.P.Q. (BNA) at 201.

144. *Id.* at 205.

works.<sup>145</sup> The definition of *scènes à faire* implies that the second work used the ideas of the prior work.<sup>146</sup>

One of the criticisms of the *Krofft* process was that too many cases would go to the jury. In reaction, many judges might broaden their definition of "idea," as was done in *Twentieth Century-Fox*, to prevent the case from proceeding to the intrinsic step.<sup>147</sup> The result is that controversies which might legitimately pass to the triers of fact are disposed of at the extrinsic step.

This supposition is borne out by the fact that no cases which have mentioned the *scènes à faire* doctrine have ever gone to the jury, even in post-*Krofft* cases.<sup>148</sup> While juries have regularly considered both the abstractions and the patterns tests, no jury has ever confronted the *scènes à faire* doctrine.<sup>149</sup> A major reason for this is the fact that many of the cases were disposed of on summary judgment motions.<sup>150</sup> Judges, however, have often used the doctrine to legitimize their findings that no infringement has occurred.

In short, when used in concert with the *Krofft* process, the *scènes à faire* doctrine affords greater protection to infringers. Hence, the doctrine is in conflict with accepted theories of copyright law and raises the possibility of allowing infringers to copy with impunity.<sup>151</sup>

## V

### Conclusion

The *scènes à faire* doctrine was a novel attempt by Judge Yankwich to clarify the extent of copyright protection. Unfortunately, however, courts have used the doctrine to limit the protection of authors from infringement.<sup>152</sup> Expressions of set-

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145. *Id.* at 207.

146. The Ninth Circuit seems to have misinterpreted its own decision in *Krofft*. In order to satisfy the extrinsic test, the court need only find a similarity of idea. *Krofft* did not distinguish between a protectable idea and an unprotectable idea, as the Ninth Circuit seems to imply in notes 134-135, *supra*. Ideas are never protectable.

147. *See supra* note 144.

148. All eight cases which mentioned the *scènes à faire* doctrine were dismissed on a summary judgment motion or were refused injunctive relief. A jury has never heard the *scènes à faire* doctrine discussed. *See supra* note 9 for a list of cases.

149. *See supra* notes 93-94 & 148 and accompanying text.

150. *See supra* note 148.

151. *See supra* text accompanying notes 110-150.

152. *See supra* sections III and IV.

tings and events, in both historical and fictional works, which might normally have been protected under traditional theories, are unprotected by the *scènes à faire* doctrine.<sup>153</sup> In addition, the doctrine presents serious definitional problems because of a lack of clear judicial guidance.<sup>154</sup> Finally, the *scènes à faire* doctrine cannot be reconciled with other accepted models of copyright protection and creates problems when applied to the *Krofft* process.<sup>155</sup>

The *scènes à faire* doctrine adds unwarranted complexity to an already complex area of law. Its recent fashionability raises the spectre of misinterpretations by judges and attorneys unfamiliar with the doctrine's consequences.<sup>156</sup> Current methods of dealing with copyright infringement, such as the abstractions and patterns tests, are adequate to cope with future technological changes and have a substantial backing in case law.<sup>157</sup> Therefore, the *scènes à faire* doctrine should be eliminated because it is an aberration in the law of copyright and unnecessary to the resolution of the issue of substantial similarity.

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153. See *supra* notes 95-109 and accompanying text.

154. See *supra* notes 110-131 and accompanying text.

155. See *supra* notes 132-150 and accompanying text. See also Berman & Boxer, *supra* note 4.

156. See *supra* notes 95-109 & 133-135.

157. See *supra* notes 34-60 and accompanying text.

[Editor's Note]:

During the time of publication several events occurred, the most significant of which was the remand of *Twentieth Century* to the lower court by the Ninth Circuit Court of Appeals. *Twentieth Century-Fox Film Corp. v. MCA, Inc.*, No. CA 80-5868, mem. op. (9th Cir. Jan. 11, 1983). The court refused to speculate on the correctness of the district court's reasoning, which discussed the *scènes à faire* doctrine. Instead, the appellate court focused on the inappropriateness of the dismissal by summary judgment motion. The court stated: "We intimate no opinion whether the films are substantially similar as to either idea or expression, but state only that reasonable minds could differ on those key factual issues. Thus, a grant of summary judgment was improvident." *Id.* at 3.

Another case examining the *scènes à faire* doctrine is *Atari, Inc. v. North American Phillips Consumer Electronics Corp.*, 672 F.2d 607 (7th Cir. 1982). The case dealt with infringement of a video game program. The court talked about the doctrine and said that certain aspects of the video game could be considered *scènes à faire*. Notwithstanding this pronouncement, the court found that the two programs were substantially similar.

A recent law review article published in a journal of the Century City Bar Association discussed the *scènes à faire* doctrine and the *Alexander* and *Twentieth Century* cases. Rosen, *Current Trends in Entertainment Litigation—The Insurance Empire Strikes Back*, 1 ENTERTAINMENT L.J. 29 (1982).



